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REMARKS

In response to the non-final Office Action mailed May 6, 2005 the Assignee submits the enclosed remarks. The Office Action rejected claims 1-48 under 35 U.S.C. 103(a) as being unpatentable over *Han* (U.S. Patent Application Publication 2003/0093293) in view of *Webb et al.* (U.S. Patent Application Publication No. 2002/0120513, hereinafter "*Webb*").

Claims 1-48 are pending in the present application. Claims 1, 6, 7, 8, 9, 11, 13, 15-17, 24-27, 29, 33, 35-37, 39, 43, and 45-47 have been amended by the present response. The present response is believed to traverse all of the prior Office Action rejections. These and other arguments are presented in the remarks below.

L THE REJECTION OF CLAIMS 1-48 (OFFICE ACTION, ¶¶ 3-4)

The Office Action rejected claims 1-48 under 35 U.S.C. § 103(a) as unpatentable over *Han* in view of *Webb*. Office Action, pp. 2-6, ¶ 5. To establish a *prima facie* case of obviousness, the Office Action must establish that (1) the prior art reference teaches or suggests all of the claim limitations; (2) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references; and (3) there is some reasonable expectation of success found in the prior art and not the applicant's disclosure. M.P.E.P. § 2142. For at least the following reasons, the Office Action has not established obviousness.

The Cited Art Fails to Disclose or Suggest All of the Elements of the Amended Claims

First, neither *Han* nor *Webb*, individually or in combination with each other, teach or suggest all of the elements of the amended independent claims 1, 15, 16, 17, 29, and 39. *Han* relates to a system and method for levying a surcharge on transactions performed by a self-service transaction device such as an automated teller machine (ATM). The user is provided a list of charities to donate the surcharge amount to. However, the user cannot avoid the surcharge since the surcharge is automatically levied on the user's transaction, and therefore the user must always pay the surcharge. *Han* does not round any amount to determine a monetary contribution, but rather, prompts the user to donate a portion of the automatically levied surcharge to a charity. The Office Action concedes that *Han* does not disclose or suggest claim elements of at least independent claims 1 and 17, including

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"determining whether the instrument is a billing instrument or a financial instrument," "if the instrument is a financial instrument, rounding the currency amount of the financial instrument downward to a lower currency amount, and determining the difference between the currency amount of the financial instrument and the lower currency amount, wherein the difference is the monetary contribution associated with the donor," and "if the instrument is a billing instrument, rounding the currency amount of the billing instrument upward to a higher currency amount; and determining the difference between the higher currency amount and the currency amount of the billing instrument, wherein the difference is the monetary contribution associated with the donor." Office Action, p. 3, ¶ 4. Furthermore, since *Han* does not relate to rounding any amount, *Han* does not teach or suggest all of the elements of Applicant's independent claims 15, 16, 29, and 39, including "rounding the currency amount of the financial instrument downward to a specified rounding level amount" (claim 15), "rounding the currency amount of the billing instrument upward to a specified rounding level amount" (claim 16), "round the currency amount of the financial instrument downward to the next whole currency amount" (claim 29), and "round the currency amount of the billing instrument upward to the next whole currency amount" (claim 39).

The Office Action cites *Webb* for the concept of rounding currency amounts. Office Action, p. 4, ¶ 4. *Webb* relates to a rounding program for a point of purchase terminal which only rounds a purchase price upwards in order to determine an investment or savings amount for a user's account, rather than for the purpose of making a donation to a third-party or recipient. *Webb* does not disclose or suggest rounding downward in any event. The Office Action concedes that *Webb* "does not specifically teach the step of rounding downward." Office Action, p. 4, ¶ 4. Moreover, *Webb* like *Han* does not distinguish between a billing instrument and a financial instrument, and only relates to a point of purchase transaction. Thus, *Webb* does not disclose or suggest claim elements of at least independent claims 1 and 17, including "determining whether the instrument is a billing instrument or a financial instrument," "if the instrument is a financial instrument, rounding the currency amount of the financial instrument downward to a lower currency amount, and determining the difference between the currency amount of the financial instrument and the lower currency amount, wherein the difference is the monetary

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contribution associated with the donor," and "if the instrument is a billing instrument, rounding the currency amount of the billing instrument upward to a higher currency amount; and determining the difference between the higher currency amount and the currency amount of the billing instrument, wherein the difference is the monetary contribution associated with the donor." Office Action, p. 3, ¶ 4.

Furthermore, since *Webb* does not relate to rounding an amount downward, *Webb* does not teach or suggest all of the elements of Applicant's independent claims 15 and 29, including "rounding the currency amount of the financial instrument downward to a specified rounding level amount" in claim 15, and the similar element in claim 29.

Moreover, since *Webb* relates to making a contribution to a savings or investment account associated with the person making the contribution rather than making a donation to an account associated with a third-party or recipient, *Webb* does not teach or suggest all of the elements of Applicant's independent claims 16 and 39, including in claim 16 "receiving a billing instrument associated with a donor," determining the difference between the specified rounding level amount and the currency amount of the billing instrument, wherein the difference is a monetary contribution associated with the donor; and transmitting the monetary contribution to a target account associated with a recipient," and similar elements in claim 39.

There is No Motivation to Combine the Cited References

Next, the Office Action fails to cite any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited references. Each of cited references relates to a respective type of transaction system with a respective purpose. *Han* relates to an ATM transaction device that automatically levies a surcharge and prompts a user to donate some or all of the surcharge to a charity; whereas, *Webb* relates to a point of purchase terminal that rounds a transaction amount upward and permits a consumer to contribute the rounded amount to an investment account. Contrary to the Office Action's assertion that *Webb* discloses a "charity account" (Office Action, p. 4, line 6), *Webb* does not even mention a use for "charity" or "charitable" purposes. In summary, one difference between *Webb* and *Han* is that *Han* relates to making a donation, whereas *Webb* relates to saving money rather than making a donation. Since these references are inapposite, and the Office Action fails

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to cite any suggestion or motivation from either reference to combine *Han* and *Webb* in the manner described, the obviousness rejection cannot be sustained.

There is No Reasonable Expectation of Success to Combine the Cited References

Third, there is no reasonable expectation of success found in the cited art. As explained above, *Han* relates to making a donation, whereas *Webb* relates to saving money rather than making a donation. Since these disparate references cannot be combined in the manner described in the Office Action, there can be no reasonable expectation of success.

The Obviousness Rejection Cannot be Sustained

The Office Action has failed to show how the cited references teach or suggest each and every element of the Applicant's independent claims, has failed to show any motivation or suggestion to combine the cited references in the manner described, and has failed to show any reasonable expectation of success to combine the cited references. For at least the reasons provided above, the obviousness rejection has been overcome and the Applicant's independent claims should be allowable over the cited references.

Dependent claims 2 – 14, 16, 18 – 28, 30 – 38, 40 – 48, are ultimately dependent from at least one of the above independent claims for which arguments of patentability have already been advanced above. Therefore, these dependent claims should be allowable over the cited references.

II. THE OBJECTION TO CLAIM 11 (OFFICE ACTION, ¶ 2)

The Office Action indicates claim 11 would be allowable if rewritten in dependent form on claim 10, including all of the limitations of that and any intervening claim. Claim 11 has been amended to correctly dependent from claim 10 rather than claim 9. Amended claim 11 is ultimately dependent from amended independent claim 1, for which arguments of patentability have already been advanced above. Therefore, claim 11 should be allowable over the cited art.

III. THE OBJECTION TO THE ABSTRACT (OFFICE ACTION, ¶ 1)

The Office Action objected to the Abstract of the specification for containing more than 150 words. The Abstract has been amended to shorten the abstract to approximately 150 words. No new matter is believed to have been introduced.

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CONCLUSION

Claims 1-48 are pending in the application. The Office Action rejections have been traversed by the present response. Claims 1, 6, 7, 8, 9, 11, 13, 15-17, 24-27, 29, 33, 35-37, 39, 43, and 45-47 have been amended by the present response. Claims 1-48 are now in condition for allowance. The Examiner is invited and encouraged to contact the undersigned attorney of record at (404) 815-6048 if such contact will facilitate a Notice of Allowance for claims 1-48. If any additional fees are due, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



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